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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 09/147,052  | 04/05/1999  | SHUJI SAITOH         | 981167                      | 1182                   |
| 23850 7590 05/02/2008<br>KRATZ, QUINTOS & HANSON, LLP<br>1420 K Street, N.W.<br>Suite 400<br>WASHINGTON, DC 20005 |             |                      | EXAMINER<br>GANGLE, BRIAN J |                        |
|   |             |                      | ART UNIT<br>1645            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>05/02/2008     | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAY 02 2008

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: PETITION DECISION  
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In re Application of:  
Shuji Saitoh et al.  
Serial No.: 09/147,052  
Filed: April 5, 1999  
Attorney Docket No.: 981167

This is in response to the petition under 37 CFR § 1.181 filed on January 28, 2008 requesting that the citation of JP5-504253 as found in the Information Disclosure Statement filed September 25, 1998 be considered by the USPTO.

## BACKGROUND

Briefly, applicants filed an Information Disclosure Statement (IDS) on September 25, 1998 which included the citation (*inter alia*) of JP5-504253 (reference AE). Corresponding to this citation, applicants indicated the date of publication of this reference; 04/27/95, indicated that the reference was a Japanese publication and further indicated, with regard to if there was a translation of this document "No. See PCT Search Rpt."

In response to the IDS submitted by applicants on September 25, 1998, the examiner mailed a signed and initialed copy of the PTO-1449 form to applicants on February 29, 2000. However, on this PTO-1449 form, the examiner struck-through the citation of JP 5-504253 as well as the citation of another reference, JP 7-503842. The examiner did not provide an explanation of why these references were struck-through and therefore not considered in any subsequent correspondence.

On August 22, 2007, a Notice of Allowance was mailed by the examiner.

On August 28, 2007, applicants submitted a letter requesting the consideration of the references which were struck-through and not considered, as reflected in the PTO-1449 form mailed by the examiner on February 29, 2000. This submission included a copy of the original IDS, as well as the PTO-1449 form signed by the examiner.

On December 28, 2007 an Office communication was mailed to applicants from Supervisory Patent Examiner Shanon Foley. This communication indicated:

While no explanation was provided in the office action dated 2/29/2000, the examiner was correct in not considering the references. No copy of JP7-503842 has been provided in this application, nor is there a mention of JP7-503842 made in the PCT search report. A copy of JP5-504253 has been provided; however, said copy is not in English, and there is no explanation of relevance of this reference in the PCT search report. Thus, neither reference has been considered.

In response thereto, applicants filed this petition under 37 CFR § 1.181 filed on January 28, 2008 requesting that the citation of JP5-504253 as found in the Information Disclosure Statement filed September 25, 1998 be considered by the USPTO.

On November 16, 2007, the Office mailed a letter acknowledging applicants' payment of the issue fee.

On March 5, 2008, the Office notified applicants of the issuance of the patent deriving from this application.

## DISCUSSION

The petition and application history have been carefully considered.

In the petition filed on January 28, 2008, applicants argue that "...the original citation of JP 5-504253 in the IDS of September 25, 1998 was proper, and that the reference should be considered and initialed by the Examiner. Applicants further cite 37 CFR 1.98(a)(3)(ii) in support of their contentions:

With regard to whether or not the references are in English, 37 CFR 1.98(a)(3)(ii) requires "a copy of the translation if a written English-language translation of a non-English document, or a portion thereof, is within the possession, custody, or control or, or is readily available to any individual designated in 1.56(c)" (emphasis added). That is, an English translation is only required under these circumstances. In this respect, the original citation of the JP5-504253 reference was fully compliant with 37 CFR 1.98(a)(3)(ii)

Applicants subsequently argue that the PCT search report which was referenced in the IDS of September 25, 1998 "provided a concise explanation of relevance", stating that JP 50504253 is referenced with an "A" on the search report.

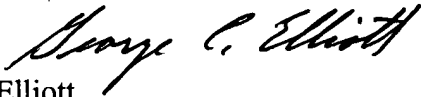
Applicants' points are well taken and persuasive.

## DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for an action not inconsistent with this decision. Namely, consideration of the JP5-504253 reference on the IDS and the preparation of an Office-generated Certificate of Correction adding this reference to the front of the patent.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



George Elliott  
Director, Technology Center 1600



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: SAITOH, Shuji, et al.

Allowed: August 22, 2007

Group Art Unit: 1645

Serial No.: 09/147,052

Examiner: Brian J. GANGLE

Filed: April 5, 1999

P.T.O. Confirmation No.: 1182

**FOR: NOVEL FUSION PROTEIN, GENE THEREOF, RECOMBINANT VECTOR  
BEARING THE GENE AND RECOMBINANT VIRUS AS WELL AS USE  
THEREOF**

**PETITION UNDER 37 C.F.R. §1.181**

**MAIL STOP PETITION**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

January 28, 2008

Sir:

This petition is in response to the Office communication dated December 28, 2007. In accordance with 37 CFR 1.181(b), Applicant here provides a Statement of Facts, Points to be Reviewed, and Action Requested.

**STATEMENT OF FACTS**

1) An IDS was filed on September 25, 1998, citing seven references, including JP7-503842 and JP5-504253, and including copies of seven references and the PCT International Search Report mailed July 1, 1997. Copies are attached of: a) the IDS of September 25, 2007; b) the International Search Report; and c) the stamped return postcard indicating receipt of these documents.

2) The PTO-1449 from this IDS was returned with the Office action dated February 29, 2000, with references JP7-503842 and JP5-504253 lined through, and with no explanation of why they were lined through.

3) On August 28, 2007, a Request for Return of PTO-1449, which requested consideration of the lined-out references JP7-503842 and JP5-504253, was filed, stating that the original IDS was proper.

4) The issue fee was paid on November 16, 2007.

5) An Office communication was mailed December 28, 2007. The communication states that the Examiner was correct in not considering these references. Specifically, the Office communication states that no copy of JP7-503842 was provided and that there is no mention of this reference in the PCT search report. The Office communication also states, with regard to JP5-504253, that the reference is not in English, and there is no explanation of relevance of this reference in the PCT search report.

**POINTS TO BE REVIEWED**

Applicant here acknowledges that the citation of "JP7-503842" in the form 1449 of the original IDS of September 25, 1998, was a typographical error, and should have been "JP7-503843," and that this is why the Examiners state that no copy of JP7-503842 was provided. (The copy of JP7-503843 was provided in the filing of September 25, 1998).

However, Applicant submits that the original citation of JP5-504253 in the IDS of September 25, 1998, was proper, and Applicant here requests that the JP5-504253 reference be considered in this application.

The two points to be reviewed are: 1) regarding the fact that the reference is not in English; and 2) regarding the concise explanation of relevance. Applicant argues with regard to the points to be reviewed, as follows:

1) With regard to whether or not the references are in English, 37 CFR 1.98(a)(3)(ii) requires "a copy of the translation if a written English-language translation of a non-English document, or a portion thereof, is within the possession, custody, or control or, or is readily available to any individual designated in 1.56(c)" (emphasis added). That is, an English translation is only required under these circumstances. In this respect, the original citation of the JP5-504253 reference was fully compliant with 37 CFR 1.98(a)(3)(ii).

2) With regard to whether the PCT search report referenced in the IDS of September 25, 1998, provided a concise explanation of relevance, Applicant has attached a copy of the PCT International search report. JP50504253 is clearly referenced (on page 3) with an "A." According

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Petition Under 37 CFR 1.181

to MPEP 609.04(a)(III), this properly provides the concise explanation of relevance for this reference. Applicant submits that the Examiner is therefore incorrect in stating (in the communication of December 28, 2007) that "there is no explanation of relevance of [JP5-504253] in the PCT search report." The original citation of JP5-504253 was fully compliant with 37 CFR 1.98 in this regard.

Applicant therefore submits that the citation of JP5-504253 in the IDS of September 25, 1998, was proper.

This Petition is timely because it is filed within two months of the Office communication mailed December 28, 2007.

#### **ACTION REQUESTED**

1) Applicant requests that the citation of JP5-504253 in the Information Disclosure statement of September 25, 1998, be considered by the USPTO to have been properly filed.

2) Accordingly, Applicant respectfully requests that the reference JP5-504253 be considered by the Examiner in this application, and that the form PTO-1449 listing this references be returned with this reference initialed by the Examiner.

3) The patent issuing for this application should list JP5-504253 as a reference considered by the Examiner.



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Petition Under 37 CFR 1.181

While it is believed that no fee is required with this Petition, the Commissioner is authorized to charge our Deposit Account No. 01-2340 for any fee which is deemed by the Patent and Trademark Office to be required to effect consideration of this statement.

Respectfully submitted,

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Daniel A. Geselowitz, Ph.D.

Agent for Applicants

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